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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/116,425	07/15/1998	ROBERT J. PIECHOWIAK	M-2760-3P	2543
24251	7590	06/16/2004	EXAMINER	
SKJERVEN MORRILL LLP 25 METRO DRIVE SUITE 700 SAN JOSE, CA 95110			CHERUBIN, YVESTE GILBERTE	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/116,425	PIECHOWIAK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yveste G. Cherubin	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 February 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-4 and 6-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 24-28 is/are allowed.

6)  Claim(s) 1-4 and 6-16 is/are rejected.

7)  Claim(s) 17-23 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the Amendment filed February 27, 2004.

#### ***Priority***

2. This application repeats a substantial portion of prior Application No. 08/727,805, now Patent No. 6,012,982 filed October 7, 1996, and adds and claims additional disclosure not presented in the prior application. The additional disclosure of "generating a first game result (randomly selected) and a bonus game result (non-randomly selected) displaying on 1 (one) display" is being given the filing date of July 15, 1998 since it was not presented in the parent application cited above. With that said, the prior art to DeMar et al., US Patent No. 6,315,660 is being considered as prior art since it carries a filing date of March 24, 1998.

#### ***Claim Objection***

3. Claims 17, 19 are objected to because of the following informalities:

Page 5, claim 17, line 1, the examiner is suggesting to replace the word "acts" between –comprising the- and –of-- by 'steps'.

Page 6, claim 19, line 1, the word "of" needs to be added between --method—and – claim--.

Page 6, claim 19, line 1, the letter "k" after the comma needs to be deleted.

Appropriate correction is required.

***Non-Final Rejection***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claypole et al. (GB No 2,262,642) in view of DeMar et al. (US Patent No. 6,315,660).

As per claims 1, 4, Claypole discloses a fruit machine operable in a first mode and a second mode, see abstract. The first game, which is a reel type game generates the game results in a random fashion and upon meeting certain predetermined criteria, a second game, which is a skill type game is initiated in the form of a quiz game or video game. However, Claypole uses two (2) displays (3, 15) to generate game results of the first game and the second game, respectively, and fails to disclose using a single display to generate both results. DeMar, on the other hand, teaches a gaming machine which includes a processor operable in a basic mode in the form of a reel type game and a bonus mode in the form of a board game, 1:32-38, 5:47-48. The first game generates its game results on video display (12), see Fig 4, 5:26-30 and upon meeting certain predetermined criteria, the video reels of the basic game are replaced with a token selection screen offering a selection of board game tokens, 11:3-6 on the same video display (12), see Fig 5. As shown, DeMar is cited to disclose generating the first game results and the bonus game results on the same video display (12) so as to require no additional hardware. It would have been obvious to one of ordinary skill in

the art at the time the invention was made to provide one display as taught by DeMar into the Claypole type device in order to minimize the cost and the size of the gaming device.

Regarding claim 2, DeMar discloses the bonus game result being a bonus award for achieving a particular first game result, 10:51-56.

Regarding claims 3, 6, DeMar discloses payout rate for various winning combinations of the basic game, 9:14-17, 10:41-49 and further discloses awarding the player for various outcomes on the board game (MONOPOLY). As shown, DeMar discloses the bonus game result identifying an additional award paid to a player.

Regarding claims 7, 12, Claypole discloses using card symbols, page 13, line 17.

Regarding claims 8, 13 Claypole as well as DeMar discloses using symbols on a video reel, 5:27.

Regarding claims 9-11, 14-16, DeMar discloses the bonus game capable of being any type of game, similar or completely different from the basic game, 1:32-39. Having the bonus game result comprising indicia, such as letters, numbers, that fills a grid pattern would have been a matter of design choice. Doing so would allow player to play a different type of game, therefore presenting a new challenging game to players.

#### ***Allowable Subject Matter***

5. Claims 24-28 are allowed over the prior art of record.

Claims 17-23 would be allowable when the Applicants make corrections to the objected claims 17 and 19 set forth above.

***Prior Arts***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. GB Patent No. 2,072,395 to Kennedy et al., which teach gaming or amusement machine.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-4, 6-28 have been considered but are moot in view of the new ground(s) of rejection. See above.

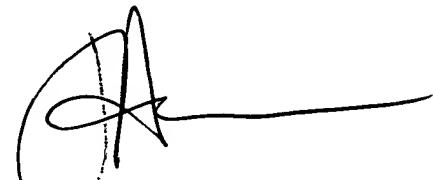
***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. Wellington can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ygc



JESSICA HARRISON  
PRIMARY EXAMINER